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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,515	06/15/2000	Judy Glenna Shannon	KINGP.55031	1096

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EXAMINER

SMITH, RICHARD A

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/595,515	SHANNON ET AL.	
	Examiner	Art Unit	
	R. Alexander Smith	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-35 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34 and 35 is/are allowed.
- 6) ☒ Claim(s) 16-25 and 28-33 is/are rejected.
- 7) ☒ Claim(s) 26 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 16-29 are objected to because of the following informalities:

Based on the Applicant's arguments with respect to the intended use of the bookmark in the book as being structural limitations, then the Examiner objects to claims 16-29 since the preamble of claims 16-29 does not state that the claims are drawn to a bookmark in combination with a book.

Furthermore, the phrasing employed with respect to the book in the claims appears as intended use and if it is the intent of the Applicant to claim the intended use of the book as limitations then the phrasing needs to be modified accordingly.

2. Claims 26 and 27 are objected to under 35 CFR §1.75(b) since claims 26 and 27 are essentially duplicate claims of claims 34 and 35, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). In this case, the slight differences is in the intended use language incorporated in the independent parent claim 16 and a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 16, 18-25, 28, 32 and 33 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane.

Bailey et al. teaches a bookmark having a flexible, elastic intermediate member or ribbon A having opposed ends. Hooks (anchors) B are attached to each of the ends.

Bailey et al. does not teach the anchors including features of a character.

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Crane teaches a bookmark having an intermediate member or ribbon with a predetermined length and width and a loop. A first abutment member in the form of a woman's head is attached to a first end of the intermediate member, and a second abutment member in the form of legs is attached to a second end of the intermediate member. When the bookmark is used with a book, the abutment members have a thickness in a direction substantially perpendicular to the length of the spine.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bailey et al. by adding the first abutment member of Crane to the top hook of Bailey et al., and adding the second abutment member of Crane to the lower hook of Bailey et al., since Crane teaches that providing a bookmark with upper and lower character portions is beneficial for increasing the aesthetic appeal of the bookmark.

With specific regard to claim 19, the depictions of Crane are considered to be "cartoon character features", since it is clear that the broad class of cartoons can include the depictions of Crane.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to additionally modify Bailey et al. by including an upper torso and limbs with the first abutment member and by including a lower torso with limbs with the second abutment member, as a choice of design, for the purpose of making a more appealing bookmark. One it is known to utilize parts of a human for the decorative effect of a bookmark, it is merely a choice of aesthetic design to include additional parts of the human body.

With specific regard to claims 23 and 28, since the intermediate member can be coiled around the lower limbs of the proposed modified device of Bailey et al., the lower limbs are

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considered to be constructed to retain a coiled portion of said intermediate member therebetween.

With regard to the top and bottom anchors being "plush", such would have been obvious to one having ordinary skill in the art at the time the invention was made, since it is clear that "plush" abutments would be beneficial since they would not scratch or otherwise mar objects while the bookmark is in use.

With regard to claims 25 and 33, the hooks of Bailey et al. are constructed for releasable engagement with each other, since they can be hooked together if desired. Also, with regard to claim 33, the preamble and the functional language "may be wrapped around an individual's wrist..." are not sufficient to set forth sufficient structure to patentably distinguish the claimed invention from the prior art.

5. Claim 17 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane as applied to claims 16, 18-25, 28, 32 and 33 above, and further in view of Ward et al.

Bailey et al. and Crane together teach all that is claimed, as discussed in the above rejection of claims 16, 18-25, 28, 32 and 33, except for the intermediate member being made from an elastomeric material.

Ward et al. teaches a bookmark with an elastomeric band A, a plurality of hooks on the band, and a line indicator on the band.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Bailey et al. by replacing the intermediate member thereof

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with the elastic band of Ward et al., since Ward et al. teaches that an elastomeric band is suitable for bookmarks that require stretching to accommodate books of various size. This proposed modification can result in the intermediate member being round as taught by Bailey et al., or flat as taught by Ward et al.

6. Claims 29-31 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane as applied to claims 16, 18-25, 28, 32 and 33 above, and further in view of Cox.

Bailey et al. and Crane together teach all that is claimed, as discussed in the above rejection of claims 16, 18-25, 28, 32 and 33, except for the first and second abutments being three-dimensional.

Cox teaches a book marker with a three dimensional ornamental element thereon. The element is in the form of a human face.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Bailey et al. by making the first and second abutments three-dimensional, since Cox teaches that three dimensional ornamental elements are known for providing a desired ornamental effect.

Allowable Subject Matter

7. Claims 34 and 35 are allowed.

8. Claims 26 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

10. Applicant's arguments filed February 9, 2004 with respect to Bailey et al., in combination, have been fully considered but they are not persuasive.

As noted in the claim objections above based on the Applicant's arguments with respect to the intended use of the bookmark in the book as being structural limitations, the preamble does not state that the bookmark is in combination with the book. Furthermore, the body of the claims with respect to the book appear written as intended use which would need to be modified accordingly. Please note that even if the bookmark is claimed in combination with the book, then it appears to the examiner that since the claims are comprising claims that Bailey et al. in view of Crane would still be capable of meeting the limitations.

The Applicant's arguments with respect to the examiner misconstruing Bailey et al. when used in combination with Crane, Ward et al. and Cox and the hooks of Bailey et al. not being anchors or abutment members is not persuasive since it appears to the examiner that the hooks clearly abut the book and anchor the bookmark within.

Abut is defined as to touch at one end or side, lie adjacent. Anchor is defined as a rigid point of support or to hold or become held in place by or as if by an anchor. These definitions are provided by the American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251.

The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RAS
May 3, 2004



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